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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,550

01/23/2006

Timothy Roberts

28573/6

1758

21710

7590

03/05/2010

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EXAMINER

PERREAULT, ANDREW D

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

03/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,550	Applicant(s) ROBERTS, TIMOTHY	
	Examiner ANDREW PERREAULT	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/27/2010, 12/03/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14, 16-19, 21, and 22 stand.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-14, 16-19, 21, and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 19 recite indefinite language such as "possible," "potentially," "substantially," and "if required" and therefore failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-14, 16-18, 21, and 22 are rejected as being dependent on rejected claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11, 13-14 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownfiel (2003/0076011) in view of Takeuchi (6,056,122).

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Re claim 19, Brownfiel discloses a device (figs 1-13) for the contained inspection and safe transportation for further examination, if required, of received mail, the device comprising a substantially rigid inspection unit (10) adapted to provide a sealed airtight environment ("air-tight" abstract), the inspection unit allowing a user to visually inspect received mail placed in the inspection unit, the inspection unit also including one or more glove members (34) allowing the user to manipulate the mail within the inspection unit; a substantially rigid transportation unit (212a) adapted to wholly receive and secure the inspection unit after inspection of the mail and to provide a further environment and physical protection for the inspection unit during transportation (paragraphs 63-66).

Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Brownfiel does not disclose that the transportation unit provides a sealed airtight environment. Takeuchi discloses similar art with reference to transportation units.

Takeuchi discloses a device (figs 1-17) comprising an internal unit ("heavy article" abstract); and, a substantially rigid transportation unit (figs 1-17) adapted to wholly receive and secure the inspection unit after user inspection of the mail and to provide a further sealed airtight environment ("airtight" and "hermetic" col. 7, line 40 – col. 8, line 18) and physical protection for the inspection unit during transportation. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It would have

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been obvious to one of ordinary skill in the art at the time of the invention to modify Brownfiel in view of Takeuchi, including that the transportation unit provides a sealed airtight environment, to provide a transportation unit that prevents damage to the internal article (col. 1, line 54 - col. 2, line 4).

Re claim 1, Brownfiel discloses an apparatus (figs 1-13) for the contained inspection and possible transportation of a potentially dangerous object, the apparatus comprising an inspection unit (10), the inspection unit including at least a first section (14) and a second section able (12) to open to receive an object and then close to provide a sealed airtight environment ("air-tight" abstract) for manual inspection of an object, the first section and the second section being substantially rigid, the inspection unit also including at least one glove member (34) allowing a user external to the sealed environment of the closed inspection unit to manipulate an object within the closed inspection unit; and a transportation unit (212a) to receive the inspection unit (10; fig 13); but does not disclose that the transportation unit including at least a first section and a second section able to open to wholly receive the inspection unit and then close to provide a further sealed airtight environment containing the inspection unit, the first section and the second section of the transportation unit being substantially rigid.

Takeuchi discloses similar art with reference to transportation units. Takeuchi discloses an apparatus (figs 1-17) comprising an internal unit, ("heavy article" abstract); and a transportation unit (figs 1-17), the transportation unit including at least a first section (2, 3, 52) and a second section (1) able to open to wholly receive the inspection unit and then close to provide a further sealed airtight environment ("airtight" and "hermetic" col.

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7, line 40 – col. 8, line 18) containing the inspection unit, the first section and the second section of the transportation unit being substantially rigid. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brownfiel in view of Takeuchi, including at least a first section and a second section able to open to wholly receive the inspection unit and then close to provide a further sealed airtight environment containing the inspection unit, the first section and the second section of the transportation unit being substantially rigid, to provide a transportation unit that prevents damage to the internal article (col. 1, line 54 - col. 2, line 4).

Re claim 2, Brownfiel discloses wherein at least a portion of the inspection unit is substantially transparent (paragraph 35, 36).

Re claim 3, Brownfiel discloses wherein at least a portion of a body section or a base section of the inspection unit is opaque, preferably of a dark colour (paragraph 35, 36).

Re claim 4, Brownfiel discloses wherein an object is an envelope, mail, package, parcel, letter or the like (fig 2, 5).

Re claim 5, Brownfiel discloses wherein the first section and the second section of the inspection unit are adapted to be clamped or latched together (fig 2, 5).

Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 6, Brownfiel discloses wherein the first section and the second section of the inspection unit are hinged together (16).

Re claim 7, Brownfiel discloses wherein the first section of the inspection unit is a lid section and the second section of the inspection unit is a body section or a base section (fig 1-13).

Re claim 9, Brownfiel discloses wherein the user can visually inspect the object in the inspection unit (paragraph 35, 36).

Re claim 10, Brownfiel discloses wherein two glove members are provided (paragraph 38).

Re claim 21, Brownfiel discloses that the inspection is provided with a sealable port (52) to receive a probe (54).

Re claim 22, Brownfiel discloses that the inspection unit is provided with a further sealable inspection port (32) having a diameter larger than the saleable port (32 is larger than 52).

Brownfiel in view of Takeuchi discloses the claimed invention above for claim 1 with the exception of the following limitations (in claims 8, 11, 13, 14, 17, and 18), further taught by Takeuchi:

Re claim 8, Takeuchi discloses that the transportation unit can generally be lifted and moved by a single person (a single person is able to generally lift the device).

Re claim 11, Takeuchi discloses wherein the first section and the second section of the transportation unit are adapted to be clamped together (fig 1, 12). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 13, Takeuchi discloses wherein the first section of the transportation unit is a lid section and the second section of the transportation unit is a body section or a base section (fig 1).

Re claim 14, Takeuchi discloses wherein the lid section and the body section or base section of the transportation unit are adapted to be press-sealed together (fig 1, 12). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 17, Takeuchi discloses wherein the transportation unit includes shock absorbing material ("hard plastic" col. 3, line 60 and line 27). Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 18, Takeuchi discloses wherein closure of the transportation unit securely holds the inspection unit placed therein (col. 1, line 60 - col. 2, line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brownfiel in view of Takeuchi (in claims 8, 11, 13, 14, 17, and 18), and further in view of Takeuchi, for the same reasons as provided above in claim 1.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownfiel in view of Takeuchi as applied to claim 11 above, and further in view of Barringer (4,460,102).

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Re claim 12, Brownfiel in view of Takeuchi discloses the claimed invention above for claim 11 (including that Takeuchi discloses double walls (double walls at 1, 2, 3, 6, and 10)) with the exception of the following claimed limitation that is taught by Barringer: two independent airtight seals (26, 27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brownfiel in view of Takeuchi, and further in view of Barringer, to provide further means to ensure an airtight seal (Barringer col. 1: 14-49 and col. 2:3-32).

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownfiel in view of Takeuchi as applied to claim 1 above, and further in view of Ziff (6,708,697)

Re claim 16, Brownfiel in view of Takeuchi does not disclose that the inspection unit also includes integrated magnifying means. Ziff discloses a similar inspection unit (fig 1-4) including integrated magnifying means (col. 3, line 54-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brownfiel in view of Takeuchi, and further in view of Ziff, including that the inspection unit also includes integrated magnifying means, as suggested and taught by Ziff, for the purpose of allowing the inside of the deice to be magnified for convenience to the user (Ziff col. 3, line 54-57).

Response to Arguments

Applicant's arguments with respect to the claims have been considered and a new rejection has been provided.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAULT whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/A. P./

Examiner, Art Unit 3728

/Ehud Gartenberg/

Supervisory Patent Examiner, Art Unit 3728